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TO: Art Unit 2127

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U.S. Patent and Trademark Office

City: Alexandria

State: Virginia

CONCERNING APPLICATION:

Applicant(s): John S. Yates, Jr., et al.

Serial No.: 09/239,194

Art Unit: 2127

Filed: January 28, 1999

Examiner: Kenneth Tang

Title: EXECUTING PROGRAMS OF A FIRST COMPUTER ARCHITECTURE ON
A COMPUTER OF A SECOND ARCHITECTURE

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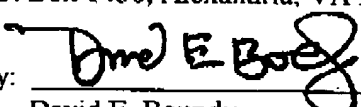
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- This FAX cover sheet
- Summary of Interview with Supervisory Examiner Meng An
- Petition Under MPEP § 706.07(c) to Withdraw Finality

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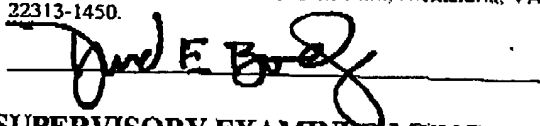
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Serial No.: 09/239,194 Confirmation No.: 9716
Applicant: John S. Yates, Jr., et al.
Title: EXECUTING PROGRAMS OF A FIRST COMPUTER ARCHITECTURE
ON A COMPUTER OF A SECOND ARCHITECTURE
Filed: January 28, 1999
Art Unit: 2127
Examiner: Kenneth Tang
Atty. Docket: 114596-05-4013
Customer No. 38492

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SUMMARY OF INTERVIEW WITH SUPERVISORY EXAMINER MENG AN

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The undersigned attorney had a telephonic interview with Supervisory Examiner Meng An on Thursday, July 7.

This attorney asked for supervisory intervention regarding the procedural issue of premature final rejection. Supervisory Examiner An stated that she did not consider such issues, that she only considered the merits. Supervisory Examiner An stated that she would not consider granting procedural relief, even if the violation of Patent Office rules complained of was purely procedural.

Supervisory Examiner An stated that she had reviewed the papers and she did not believe that a "new ground of rejection" had been raised. This attorney asked if she had any written rule or publication that supported any definition of "new ground of rejection" that she might be applying. Supervisory Examiner An stated that she did not. This attorney directed Supervisory Examiner An to the definition of "new ground of rejection" stated in *In re Kronig* and *In re Wiechert* and requested that she review the quotes from these cases at pages 1-2 of the Request to Withdraw Finality of Office Action of March 21, 2005. She declined to read that paper. This attorney asked Supervisory Examiner An if she had any basis to disagree with the court's holding in *Wiechert*. She declined to answer the question. This attorney asked Supervisory Examiner An if she had authority to disregard the CCPA. She declined to answer this question.

Summary of Interview with Supervisory Examiner
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This attorney twice asked Supervisory Examiner An if she would like to take a couple days to find some written rule that would overrule *Wiechert* or create an exception, or support her view. She stated twice that she would not do so.

Supervisory Examiner An suggested that Applicant should respond in papers. This attorney noted that the position had already been set out in papers, and those papers had been before the examiner twice, once when originally filed in March, once when reconsideration was requested by phone in May. This attorney noted that the examiner's responsive papers had failed to address the procedural issues raised in Applicant's papers, and had failed to provide any requested clarification on the merits. Supervisory Examiner An reiterated that Applicant should respond in papers. This attorney asked Supervisory An why filing the same arguments and requests for clarification a third time would ensure that they received a proper response, when no response had been given them in the past. Supervisory Examiner An declined to answer the question; she simply reiterated her position that a further set of papers should be filed.

Supervisory Examiner An stated that an applicant is responsible for reading the entirety of any reference cited by an examiner (including, apparently, all 144 columns of the Chernoff '028 reference), and that an examiner may freely rely on new portions of an existing reference without introducing a "new ground of rejection." This attorney asked if Supervisory Examiner An knew of any written statement to that effect; Supervisory Examiner An stated that she did not. This attorney invited Supervisory Examiner An to review the quote from *Wiechert* in the Request, which states exactly the opposite of her view. Supervisory Examiner An declined the invitation.

Supervisory Examiner An stated that the issues on the merits should have been addressed by telephone interview with the examiner. This attorney agreed, and noted that an interview with the examiner had been requested on a number of occasions. This attorney noted that the examiner had declined all requests for an interview. We did not reach an agreement for how to proceed on this issue.

Supervisory Examiner An conceded that Examiner Tang's papers were not clear, and yet asserted that clarification of those positions was not a "new ground of rejection." She provided no authority for this definition of "new ground of rejection."

This attorney asked how Supervisory Examiner An made sure that her examiners made correct and fair determinations on the merits, if she enforced no requirements of procedure.

Supervisory Examiner An declined to answer the question; she reiterated that Applicant should file whatever papers were deemed appropriate.

It is believed that this paper occasions no fee. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-05-4013.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: July 25, 2005

By: 

David E. Boundy

Registration No. 36,461

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PATENT

ATTORNEY DOCKET NO. 114596-05-4013

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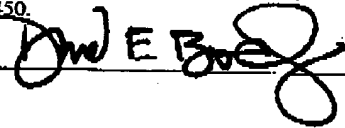
Art Unit: 2127

Examiner: Kenneth Tang

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AFTER FINAL – EXPEDITED PROCEDURE

PETITION UNDER MPEP § 706.07(c) TO WITHDRAW FINALITY

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioner petitions for reopening of prosecution, after prosecution was prematurely closed by the Office Action of January 13, 2005. The Examiner adhered to his view after reconsideration, in his paper of June 1, 2005. Pursuant to MPEP § 706.07(c) and (d), Petitioner requests that prosecution be reopened, and that the Response to Office Action filed March 21, 2005 be entered as of right.

The following two questions are presented:

1. Does the Office Action of January 2005 add a new grounds of rejection for claims 1, 5, 33 and 79 not necessitated by amendment?

Yes. First, under controlling precedent, a “new ground of rejection” arises when a subsequent Office Action “is factually based on an entirely different portion of an existing reference” relative to an earlier Office Action. The January 2005 Office Action is the first to rely on a new portion of a reference, and a totally new reference, and therefore introduces a new ground of rejection. The June 2005 Advisory Action expressly concedes that the last Office Action “further expands on prior art” relied upon. The January 2005 Office Action for the first time gives explanations of the Examiner’s position. Claims 1, 5, 33 and 79 were not amended in any way material to the new portion of the reference. The Examiner

thus concedes all facts relevant to MPEP § 706.07(a), and final rejection is premature.

2. When a purported "rejection" is based on reasoning that is expressly forbidden by the MPEP, can that violation of PTO rules mature into a final rejection?

No. Under the administrative law, when an agency employee violates agency procedures, the action is "illegal" and "void." Thus, there is no rejection. A non-rejection cannot be a final rejection.

I. The Issues Raised Here are Petitionable, Not Appealable

The Federal Circuit¹, the Board of Appeals, and the Director have all held that petition to the Director under Rule 181 is the appropriate avenue to raise untimely examination, or examination in violation of PTO rules, at least where the only relief requested is reopening of prosecution.

The Board of Patent Appeals and Interferences has long held that premature closing of prosecution is never appealable. *Ex parte Fine*, 217 USPQ 76, 79 (Bd. Pat. App. 1981) (precedential) ("We are likewise not concerned with the allegedly premature nature of the final rejection... This is an administrative matter subject to petition, not a substantive matter within our jurisdiction."); *Ex parte Secor*, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd981052.pdf> (BPAI 2002) (unpublished) (premature final rejection "is reviewable by petition to the Director rather than by appeal to this Board."). Petitioner has diligently sought, and has been unable to find, a single case since 1964 in which the Board reviewed an issue of premature final rejection. There are none.

Second, the Board has held that issues arising under MPEP procedures, even those relating to claims, are never appealable – the Board only reviews issues arising under the substantive portions of the Patent Act. *E.g.*, *Ex parte Huas*, 175 USPQ 217, 220 (Bd. Pat. App. 1972) ("If the examiner fails to follow the Commissioner's directions in the M.P.E.P., appellant's remedy is by way of petition to the Commissioner since this Board has no jurisdiction over the

¹ *In re Alappat*, 33 F.3d 1527, 1580, 31 USPQ2d 1545, 1588 (Fed. Cir. 1994) (*en banc*) (Plager, J., concurring) ("The [Director] has an obligation to ensure that all parts of the agency ... conform to official policy of the agency..."); see also *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1284-85, 73 USPQ2d 1409, 1414-15 (Fed. Cir. 2005) ("petition process [is] the 'exclusive administrative check' on the discretion of examiners," to ensure that examiners act within the PTO's rules).

examiner's action.") (Lidoff, examiner-in-chief, concurring), *rev'd on other grounds*, 486 F.2d 1053 (CCPA 1973).

Because the issues presented in this petition, and the relief requested, are not appealable, they must be addressed when presented by Petition. 37 C.F.R. § 1.181(a)(1).

Third, the Commissioner of Patents and Trademarks (now the Director) holds that where the sole relief requested is reopening of prosecution because of breaches of Patent Office procedures – as in this petition – the issues are petitionable, even if the underlying issue might involve some consideration of the merits. *In re Oku*, 25 USPQ2d 1155, 1157 (Comm'r Pats and TM 1992) (emphasis supplied):

The designation of a new ground of rejection, while involving a consideration of the merits, also involves the important question of whether the Board followed PTO regulations established by the [Director]. ...

A decision to reopen prosecution ... is a question solely within the discretion of the [Director] and is in no way a review of a merits decision ...

Finally, issues are petitionable when "the rules specify that the matter is to be ... reviewed by the Director." 37 C.F.R. § 1.181(a)(2). The relevant rule is MPEP § 706.07(c), which instructs as follows:

706.07(c) Final Rejection, Premature

Any question as to prematurity of a final rejection ... is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

The questions presented are within § 1.181(a)(2).

This Petition is timely presented within two months of the examiner's action on reconsideration of June 1, 2005.

II. The Office Action of May 2002 Raises Three "New Grounds of Rejection," Preventing Finality

An Action may not be made final when it introduces a new ground of rejection, where the new ground was not necessitated by an amendment. MPEP § 706.07(a).

The issues raised in §§ II.A, II.B, II.C and II.D of this petition turn on the definition of the term "new ground of rejection." The MPEP states no definition for this term. Thus, we must

look to court and Patent Office precedents for a definition of the term. Under the precedential definition, the January 2005 Office Action raises a "new ground of rejection" of an unamended claim, and final rejection was premature.

A. Reliance on a new, unrelated portion of a reference, is a "new ground of rejection"

A "new ground of rejection" is any new line of reasoning that requires a "fair opportunity to react to the thrust of the rejection." *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976). For example, relying on new portions of the same references, for disclosure not found in portions previously relied on, is a "new ground of rejection." *In re Wiechert*, 370 F.2d, 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... When a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference," emphasis added). See also 37 C.F.R. § 1.104(c)(2) (examiner must designate every portion of a reference relied upon – implying that relying on new portions constitutes a new ground of rejection).

Dozens of decisions of the Board hold that a different rationale on identical references is a "new ground of rejection." E.g., *Ex parte Bollinger*, 2004 WL 366295 at *3-*4, fd040106.pdf at 7-8 (BPAI 2004) (the Board's different "rationale" on identical references is a "new ground of rejection"); *Ex parte Mattel Inc.*, 2003 WL 22282332 at *10, fd030162.pdf² at (BPAI 2003); *Ex parte Coe*, 1995 WL 1747721 at *5 (the Board's different "basic thrust" on the same references is a "new ground of rejection").

The Examiner himself admits that he has "further expanded the prior art" to develop a new rationale.

At page 5, line 19 and page 20, line 5, the January 2005 Office Action adds col. 33, lines 1-9 of Chernoff '028 as a new ground. (Compare Action of June 2004, page 6, line 17). This portion of Chernoff discusses entirely different subject matter than the portions of Chernoff '028

² All citations to PDF copies of Board decisions are to publications of the Patent Office at URL http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd____.pdf.

previously relied upon. Neither claim 1 nor claim 5 (the two independent claims to which this portion of the Office Action is relevant) were amended in any way relating to this limitation.

The Advisory Action of June 2005 then expressly concedes that a new ground of rejection is raised. It states "adding col. 33, lines 1-9 of Chernoff '028 supports and further expands on prior art..." "Further expanding" the prior art is exactly the type of "entirely different portion of an existing reference" that the CCPA characterized as a "new ground of rejection."

The Examiner is unable to cite any authority for a definition of "new ground of rejection" that overrules *Wiechert* and *Kronig*, or that excuses his late addition of "expanded" prior art. On the facts as the Examiner states them to be, the January 2005 Office Action raises a new ground of rejection.

B. A new discussion of a claim, where the previous Office Action was silent, is a "new ground of rejection"

The Board has held that an examiner's silence, when cured, can constitute a "new ground of rejection," *Ex parte Mathur*, 1996 WL 1795838 at *9, fd954103 at 20-21 (BPAI 1996)

(citations and quotations omitted):

The examiner did not notify appellants [of his reasons for maintaining the rejection]. [If] the examiner had previously pointed this out to appellants, appellants would, at least, have had notice and would have had an opportunity to file objective evidence. The examiner's failure to put appellants on notice as to the lack of objective evidence in support of their argument concerning unexpected properties constitutes a second separate reason to denominate our affirmance of the examiner's decision as a new ground of rejection....

Here, the examiner has been silent, and his first attempt to address an issue is a "new ground of rejection."

Claim 79 recites "the linkage return address being deliberately chosen so that an attempt to execute an instruction from the linkage return address on return from the service routine will raise a program execution exception." There is no dispute on the facts. The June 2004 Office Action was absolutely silent on this claim language: paragraph 57 of the June 2004 Office Action asserts that claim 79 is "rejected for the same reasons stated in the rejection of claims 1 and 33." This cannot be so. Neither claim 1 nor claim 33 recite similar language. Because the June 2004 Office Action is incomplete, it raises no rejection whatsoever of claim 79. The

Examiner does not contest that the June 2004 Action made no mention of claim 79, and thus did not reject claim 79.

Claim 79 has not been amended during prosecution.

The first attempt to compare this claim language to any reference appears in ¶ 55 and 102 of the Action of January 2005. This is a "new ground of rejection," preventing final rejection.

C. Reliance on a new reference in the circumstances of this case is a "new ground of rejection"

Paragraph 102 of the January 2005 Office Action adds a totally new reference, DiBrino 5,371,894, in connection with claim 79.³

In a few circumstances, a new reference may be added without raising a new ground of rejection, but these circumstances are not present here. For example, MPEP § 2144.03 only permits a "free" addition of a new reference when the initial assertion of Official Notice was accompanied by "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." As noted in section II.B above, the

³ A new reference, even one offered to back up a previous assertion of official notice, is a new ground of rejection. The CCPA has stated that a new reference "always" constitutes a "new ground of rejection." *In re Ahlert*, 424 F.2d 1088, 1092 n. 4, 165 USPQ 418, 421 n. 4 (CCPA 1970) (when the Board cites a new reference to back up an assertion of official notice, "it is not uncommon for the board itself to cite new references, in which case a new ground of rejection is always stated," emphasis added); *Ex parte Skinkiss*, Appeal No. 2000-0226, fd000226.pdf at 4 n. 1 (BPAI 2000) ("new piece of evidence," even an assertion of "well-known custom," constitutes "a new ground of rejection").

Paragraph 102 states that the addition of DiBrino is not a "new ground of rejection." The Office Action cites no authority that would support this contention.

The Federal Circuit has made clear that no rejection may rely on bald assertion or common sense; rejections may only build on evidence drawn from one of the categories of § 102. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("the Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.") and *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) ("common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation... The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies").

If the new DiBrino reference is not part of the ground of rejection, then there is no rejection at all. The Examiner cannot have it both ways.

June 2004 Office Action was silent on the "linkage return address" language for which the new reference is introduced.

There is no question that such "specific factual findings" were lacking from the Action of June 2004. Thus, the "free" new reference rule of § 2144.03 does not apply, and the new introduction of the DiBrino reference in January 2005 is "newly cited art" that prevents final rejection under MPEP § 706.07(a).

D. The January 2005 Office Action is the first to explain a rejection, and thus constitutes a "new ground of rejection"

A new explanation for a § 112 ¶ 2 rejection is a "new ground of rejection." *Ex parte Sigmundstad*, 2000 WL 33910099 at *3, fd000560.pdf at 8-9 (BPAI 2000); *Ex parte Teeple*, 1997 WL 1883925 at *2-*2, fd970943 at *9 (BPAI 1997); *see also Ex parte Doodson*, 1998 WL 1735578 at *2, fd980003 at 4-5 (BPAI 1998) (where examiner's papers were "not a model of clarity," clarification was a "new ground of rejection"); Summary of Interview With Supervisory Examiner Meng An at 2 (conceding that Examiner Tang's papers have not been clear).

Paragraph 96 of the January 2005 Office Action for the first time provides some explanation for how claim language that does not use the words "the" or "said" can possibly lack "antecedent basis" under § 112 ¶ 2. Without the newly-provided explanation, no applicant could have understood the nature of the rejection. This is a new "thrust" that requires a "fair opportunity to react," and a "new ground of rejection" that renders final rejection premature under MPEP § 706.07 and § 706.07(a).

III. The January 2005 Office Action Acts Outside the Scope of Authority or Discretion Granted by the Director – an Unauthorized Act Cannot Mature into a Final Rejection

The Examiner has acted outside the discretion granted by the Director. MPEP § 2143.03 states that "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art" (citations and quotations omitted). At ¶ 55 of the January 2005 Action, the Examiner expressly admits that neither reference teaches or

suggests the "linkage return address" language of claim 79. Yet he purports to reject the claim anyway.

Only the Director has the authority to reject claims, 35 U.S.C. § 132, and examiners only have such authority as the Director delegates. Restatement 2d (Agency) § 7 (where a principal, such as the Director, communicates his instructions to his agent, such as an examiner, to third parties, the agent only has such authority as set out in that objective manifestation of the scope of the delegation). When an examiner acts outside the written consent delegated by the Director, no rejection exists.⁴ Prosecution may not be closed when an examiner has acted beyond his authority.

Because there is no rejection whatsoever of claim 79, prosecution should be reopened to allow the Examiner to properly and fully examine this claim, within the authority granted by the Director.

IV. Most of These Issues Have Been Discussed With the Supervisory Examiner

As noted in the accompanying "Summary of Interview with Supervisory Examiner Meng An," Petitioner attempted to discuss these identical issues with the Supervisory Examiner.

Surprisingly, she stated that she would not supervise procedural issues. She insisted that she would only consider issues on the merits. She recommended that Petitioner simply ignore the procedural defects in the examination, and file another paper addressing issues on the merits. When asked, she was unwilling to offer any assurance that any future paper would be addressed under correct procedures.

Written procedural rules matter. It is the only way that two parties can agree on the rules that govern their mutual conduct. When government employees simply make up the rules as they go along, refuse to follow the agency's written rules, and refuse to acknowledge that an

⁴ An action taken in violation of an agency's own regulations is "illegal and of no effect," *Vitarelli v. Seaton*, 359 U.S. 535, 545 (1959); *IMS, P.C. v Alvarez*, 129 F.3d 618, 621 (D.C. Cir. 1997) (it is a "well-settled rule that an agency's failure to follow its own regulations is fatal to the deviant action").

Jurisdictionally, a question that "involves the important question of whether the [examiner] followed PTO regulations established by the [Director]" is petitionable, especially when the sole relief requested is reopening prosecution. *Oku*, 25 USPQ2d at 1157; *Haas*, 175 USPQ at 220, both quoted above. Also, because as a matter of administrative law, there is no rejection, any question of non-petitionability of issues relating to rejections does not apply.

agency's or reviewing court's precedents have any effect, proceedings are reduced to anarchy. Supervisory Examiner An repeatedly outright refused to acknowledge that written rules control her examiner's conduct – she did not state that she believed that she and her examiner had complied with the PTO's precedents, she stated that she would not even consider what the written rules and precedents have to say, and would not review the written rules to make sure her view is correct.

This was a violation of her duties to this applicant and to the Patent Office.

V. Conclusion

The Board notes that the Patent Office cannot fairly or efficiently perform its substantive duties without observing and enforcing its procedural rules relating to “new grounds of rejection,” including the right to make amendments unencumbered by premature final rejection:

Late discovery of relevant evidence in any proceeding can cause procedural discomfort. Be that as it may, appellants are still entitled to fully and fairly respond to an examiner's action. Here, the examiner's citation of and implicit reliance on eight new references in the Examiner's Answer while at the same time denying that a new ground of rejection has been made and then denying appellants any opportunity to respond to the newly cited references cannot be said to result in appellants' having a “fair opportunity to react to the thrust of the rejection.”

Mathur, 1996 WL 1795838 at *5, fd954103 at 9-10. Here, the examiner's attempt to have things both ways is a denial of procedural due process.

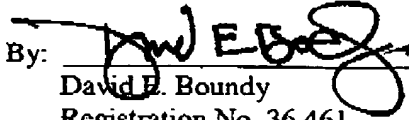
For these reasons, the finality of the Action of January 2005 should be withdrawn. The Amendment and Information Disclosure Statements filed in March 2005 should be entered as of right (even without a showing of reasons under Rule 116).

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit
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Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: July 25, 2005

By: 
David E. Boundy
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